

disclosure or teach. Applicants' attorney interpretes this requirement to mean the above identified application (guessing he original U.S.) must disclose and discuss the election of species and how it relates to support the after-filed application. As this is an impossibility, applicant's attorney will incorporate the following discussion of the history of the ORIGINAL U.S., the CIP, the PCT and the Canadian applications into THIS APPLICATION (the CIP)

## REMARKS

This application has a long history dating back to the original US filing of 09/301,868, filed 4-29-1999, filed by a prior attorney of record. This filing was followed by an election of species by the prior attorney, a CIP filed by applicant's present attorney of record, a PCT filing of the original U.S. application, a PCT filing of the CIP application, a filing of the PROCESS application etc. Each filing references the parent application (09/301,868) so that the chain of history could be followed. The examiner is of the opinion that some sort of history of filings with subsequent election of species etc. should be disclosed in the patent applications which have been abandoned upon the filing of the CIP (this applicant's attorney is at a loss as to how to comply with the precise wording of the examiner). In the present office action, the examiner seems to be requiring the amendment of the parent applications to also include a history of the subsequent CIP, PCT etc filings. This is probably not what the examiner intended by the words:

"The disclosure of the prior-filed application identified by the examiner as Application No. 09/301,868, fails to provide adequate support for "THIS" application (emphasis added). The examiner continues that the election of species are not disclosed or taught fairly in the prior-filed application. This is the language which seems to require the amendment of the prior-filed application. Applicant's attorney respectfully traverses the examiner's requirement, however, in an attempt to comply with the examiner's requirement, Applicant's attorney is proceeding to simply to modify "THIS" application with adequate explanation of the history of "THIS" application even though all of the history is "of record" in the USPTO files.

The patent examination process measures if a significant inventive process has been demonstrated by the applicant so as to grant certain rights.

One of the measures is the solution of a problem that has not been solved before by others because if it has previously been solved, then the requirement for a new inventive step has not been established and no patent rights are earned.

Discussion of history of prior art in "THIS" application's parents:

The Examiner in this application has found that others have solved the problem sought to be overcome by the present invention and has thus denied any inventive step to the applicant.

The history of the prior art cited by the examiner contained in the file of this application as well of in the file wrapper of the parent application and PCT application with the resulting Canada application which resulted in an issued patent 2372038, filed 4/27/2000 consists of:

SELZ = an empty cup that can be attached to an open beverage bottle container or open beverage can container to preserve the contents of the container as well as used as a vehicle to consume the contents of the container.

BARNES et al. = packaging for storing and cooking an omelet consisting of a can of eggs and can of filling fastened together so that the purchaser may open the filling pour the contents into the container of eggs and then cook the mixture into an omelet within the

container using an external, user source of heat.

ZOTLLER et al. = spiral slit container allowing said container to be subject to easy zip open packaging surrounding raw dough and a can of frosting or topping to be applied to the dough after the dough is cooked.

LaBARBERA = an over-cap closure device.

most of the prior art cited by the examiner stems from a foreign search report, the international preliminary examination report performed under international application no. PCT/US00/11269.

This search report was completed 12 July 2001 by HAO MAI, authorized officer and Jean Proctor, paralegal specialist. Mr. HAO MAI is no longer employed by the USPTO. My efforts to contact him by phone shortly after receiving the international search report were unsuccessful. My request for Status dated March 2001 of the underlying U.S. patent application to which Mr. MAI cited the same prior to the PCT patent application as well as my response dated October 21, 2002 to the international search report to Mr. HAO MAI remain pending in the USPTO. The present status of the file is that the U.S. Patent application was recently revived on petition so is in good standing to support this pending Canadian Patent application.

#### International Search Report Analysis -

From section 2. citations and explanations:

Claims 1, 6, 10, 14-15 and 17 lack an inventive step under PCT Article 33(2) as being obvious over SELZ (4,693,410).

. The report characterizes the teaching of SELZ as teaching a

“drink bottle providing a cylindrical bottle wall joined axially with a diminished diameter bottle neck, the bottle neck terminating at a removal bottle cap;  
(This is language quoted from the application by Mark Beckman, see it set forth in claim 10)

AND (emphasis added)

a snack package fabricated as an envelope having an inner wall and an outer wall having a sealable opening mounted on the outer wall for removably receiving a snack food, the snack package envelope having a cylindrical envelope outer wall joined to the inner wall, terminating with an aperture at one end thereof, the aperture having a size and shape for accepting the bottle neck and removable cap and located so the under the condition of the aperture engaged with the bottle neck and cap, there is a positioning of the inner surface of the snack envelope inner wall intimately against the bottle wall for securement therewith (fig.13) (emphasis added), the aperture further providing a concentrically oriented cylindrical inner wall for engagement with the bottle cap, the snack envelop extending diametrically from the bottle wall no more than by the thickness of the outer envelop wall (figs. 17-18).”

(This language is also from the Beckman application, claim 10 EXCEPT for (fig. 13) and (figs. 17-18). **The claims contain no references to figures.**

The true fact is that the Beckman application does not contain a **figure 13, 17 or 18**. Hence, the insertion in the International Report must be a reference to figures from

SELZ. An analysis of the figures of SELZ follows.

A reading of SELZ discloses a teaching of a plastic drinking cup which may be connected to the OPEN ENDS of bottles and/or OPENINGS in the top walls of metallic or plastic CANS to sealingly engage with and to swivel relative to the partly spherical external surface of a bottle or can.

SELZ provides a cup attached to a bottle or can to dispense and consume the contents of the container with part of the cup functioning as a removable closure to retain liquid inside the container for a partially emptied bottle or can. The closure, while retaining the liquid, such as a carbonated beverage, provides a relief valve so that the internal pressure will not disengage the closure and allow the remaining liquid to spill. The cup may be disengaged manually, without opener or tools, and the remaining liquid dispensed.

Upon careful reading and computer search of SELZ, nowhere is disclosed the words or phrases:

- Envelope
- Snack package
- Bottle neck
- Removable cap
- Securement of envelope

Attached is Fig. 13, as referenced in the report, for your examination to verify that the container is empty and cannot be filled with product and then attached to the beverage bottle.

The teaching of SELZ, for Fig. 13 is:

FIG. 13 shows a modified vessel which has a substantially cylindrical cup 1 and a closure 20 which can be applied to the upper portion of metallic or plastic can 21. As shown in Fig. 14, the top wall portion 25 of the can 21 has a customary lift-off lug 22 which is connected with an integral section 25a of the top wall portion 25 and can remove the section 25a so as to form an opening 39 (FIG. 22) bounded by a marginal zone 38 of the top wall portion 25. An important advantage of the vessel of FIG. 13 is that it comprises a closure 20 which can seal the opening 39 from the surrounding atmosphere, a task which cannot be achieved by resorting to customary corks or analogous stoppers.

There is no snack package or snack contained within cup 1. The sealing of the cup 1 to the can 21 is at the open end 25. Fig. 17-18 of SELZ are also attached. In the SELZ patent, Fig. 17, attached here to, shows the combination of a can 21 and a vessel which is similar to the combination of Fig. 13 except that the closure 20 comprises a single annular seal 23. This the peripheral portion 28 of the bottom wall 29 of the cup 1 is spaced apart from the conical surface 36 of the marginal portion 27 of the can 21 when the internal shoulder 30 of the marginal portion 27 of the can when the internal shoulder 30 of the tubular wall 12 engages the lower edge face of the bead 31.

Fig. 18, also attached, shows a further modification with a closure 20. ... The structure Fig. 18 is desirable and advantageous when the manufacturer of the cup 1 desires to further reduce the likelihood of escape of some liquid into the space between the tubular wall 12 and the external surface of the cylindrical wall 50.

The inventive step of SELZ is to provide a cup, attachable to a beverage container be it a bottle or can to seal said beverage container to prevent spilling any remaining liquid within said container until the user is ready to consume the remaining liquid, which may be accomplished directly from said container or by means of the cup.

SELZ does **NOT** suggest filling the cup with anything other than the contents of the open beverage container. SELZ does teach inserting the beverage container into the cup for convenience but fails to teach attachment to the container other than to an open container.

#### Analysis of Milk bottle Patent US 5,318,787 (BRAUNER)

Cited by U.S. Examiner in the international search report, applicant's attorney's analysis is as follows:

The object of this patent is to provide a safe distribution of a FREE sample (emphasis added) of a co-product such as a breakfast cereal to the purchaser of milk in an effort to entice the purchaser to try out the product in anticipation of generating a market for the sampled product. It is no more "inventive" than the attachment of a free sample of a bar of soap, an envelope of body cream, or even just a coupon to the plastic wrap of a newspaper or magazine. The idea is marketing of a small sample of a product using an existing distribution system not to add value to the newspaper or magazine. Had the invention managed to attach a box of cereal to a container of milk so that the purchaser could simply grab one item and pay for it as a convenience rather than having to go to the milk case and then go over to the cereal shelving, the invention may be applicable as prior art to the Beckman application. However, because BRAUNER only attaches a cup of cereal to the gallon of milk and the attached container is not even taught to be usable as a bowl into which the milk can be poured and from which the cereal may be consumed, the BRAUNER combination is clearly a marketing sample device not a convenience nor an add on product for which the seller may increase the price. The Beckman invention is to combine a snack and a beverage into the same space as a beverage thereby allowing the vender to increase the price of the item while providing two consumable items that do not require additional utensils to consume. The present invention is to add value to an existing product within its distribution system at a point that does not interfere with the existing product and may even enhance the existing product such as adding peanuts to a bottle of cola, a favorite combination.

The milk patent' 787 teaches using unused space in a milk distribution box to distribute a free sample of a new product in a manner that protects the free sample and does not interfere with the primary product. The invention does not teach adding value to the primary product so that the price of the combination of the primary product and the sample may be increased resulting in increased efficiency and profit by utilizing the existing distribution system.

The present invention expressly teaches the increased efficiency of use of existing space by combining two vending or distribution systems into a single system by using underutilized space in the bottle distribution system – filling the unused space with a companion product thereby allowing the vending or distribution system to increase revenue with minimal increase in effort (the attachment of the companion product to the bottle before insertion of the bottle into a vending machine or placement at a distribution point such as a concession stand at a ball park.

#### Analysis of products stuck together by tape or mounted in a container with a spiral opening"

The examiner has rejected the Beckman claims in view of BARNES as it discloses a adhesive tape to join the upper and lower container. However, the containers are for eggs and additions to eggs after which the mixture must be cooked into an omelet requiring not only kitchen utensels but a stove. Very different from a snack and a beverage, both instantly consumable food product. Further, the use of tape by Barnes is to associate the two cans which must be stacked on a shelf with no teaching of associating the cans in the same space in a vending machine formally occupied by only one of the cans.

The use of tape to associate products or to hold things in place is well established in the art and is not considered or claimed by Beckman to be an inventive step by the applicant. The claims involving the use of tape are dependent in nature and contain all of the limitations of the claims upon which they depend which applicant's attorney respectfully adheres contains an inventive step. Hence these claims should be allowable.

If all the packaging solutions that have been invented to date are to be used as prior art to prevent the patenting of any product now invented that requires packaging, without consideration of the inventiveness of the unpackaged product, no products that are packaged can possibly be patented no matter how inventive the product. Applicant's attorney respectfully traverses the examiners rejection of the underlying invention of the product just because it is packaged in some manner and that manner is used in the prior art to package a dissimilar product for a dissimilar purpose.

The examiner has rejected the Beckman claims in view of ZOELLER et.al. because ZODLLDF teaches combining raw dough which must be cooked and a can of topping such as frosting which may be slathered on the dough after it is cooked. Again, this invention requires not only utensels but an oven and assembly before consuming the food. Far different from a snack and a beverage which can be immediately consumed without assembly and cooking.

Making a package easy to open by providing a spiral seam such as used by ZOELLER is not claimed by applicant to be an inventive step as the spiral slit is set forth in a dependent claim incorporating all of the limitations of the claims upon which it depends.

Further, both BARNES and ZOELLER are packaging solutions not the invention of a combination of products that can be vended from the same space or assembled to be sold as a unit at a ball park so that only one item has to be handled and rung up as a sale with combined value. The ball park does not generally provide a stove or oven to cook food purchased from a vender or from a vending machine as required to use the product in ZOELLER device .

LaBARBERA teaches an over-cap device that snaps down over the dispensing spout. The inventive step in LaBARBERA is a cap resulting in a top surface without sink marks. The attachment of an over-cap as taught by LaBARBERA is not claimed as an inventive step by Beckman. The container or cap of the Beckman invention contains a snack. LaBARBERA's cap is protective and cosmetic in nature without any teaching of placing any product whatsoever within the over-cap before it is attached over the dispensing spout of the container containing the product to be used by dispensing it from the over-cap protected dispensing spout. The Beckman invention fills the CAP with a snack and then attaches it over or around a beverage container. It does not protect the beverage container opening.

BECKAMAN on Kaufman

Comment on Product/Process difference on Process and Beckman product app as prior art.

In the present office action, the examiner has again cited Kaufman, US 6,247,612 as significant prior art that results in the rejection of the claims.

Upon close reading of Kaufman, applicant's attorney applauds Kaufman for hitting the jackpot. Kaufman managed to obtain a single patent that covers:

1. A method for dispensing a product by chance, Claim 6

A process for dispensing a product by chance, Claim 10;

An apparatus for dispensing a product by chance, Claim 1, and

A gambling machine, Claim 12.

In my many years of practice, applicant's attorney has never been so lucky. The examiners I have been assigned have usually required a divisional or an election of species for such an application so that a multiple application process with multiple fees and multiple responses had to be pursued. I really tip my hat to Kaufman and his attorney.

Applicant's attorney continues to respectfully traverse examiner's opinion that Kaufman is proper prior art to the Beckman/Perez patent application. Kaufman may show the state of the art that is vastly improved by the solution to a desired problem shown in Kaufman – how to use a vending machine in such a manner as to increase the marketing and attraction of the vending machine. Most vending machines just stand there waiting to be found. This machine is shown to have attractive advertising and to promoting gambling.

The claims of the patent do not guarantee that upon deposit of the required sum of money to dispense something from the machine that the item dispensed will be a promotional item. The claims require the machine to be loaded with the product and "at least one promotional item". See page 8, lines 17-18 for claim 1, page 8, lines 55-57 for claim 6, page 9, lines 28-30 for claim 10 and page 10 lines 21-23 for claim 12. There is no requirement that the machine be loaded with a one to one corresponding product and promotional item in any of the claims.

Looking closely first at the promotional item and then at the product:

#### PROMOTIONAL ITEM

The inventor uses a beverage container for the packaging of the promotional item. The beverage container is split vertically in one embodiment and horizontally in another embodiment. If there were any beverage in the beverage container the beverage containing component of the beverage container is completely compromised. If splitting the container did not compromise the beverage containing ability of the beverage container the inventor teaches stuffing the beverage container with the tee shirt that is first compacted into the beverage container shape but smaller than the beverage container into which it is to be stuffed. This leaves no room for beverage or snack in the container. The split container is then taped closed with the label, with tape or with shrink wrap so that the tee shirt does not fall out of the split container. The now filled promotional container is mounted into one slot of the vending machine; again without requirement that there be a one to one correspondence for mounting one promotional item each time a product is mounted into the vending machine.

The product is packaged in a container similar to the beverage container chosen to enclose the promotional item. In this manner, the vending machine may be maintained with product and promotional item.

The gambling may now begin according to the teaching of the patent. Without a requirement that there be a one to one correspondence of product and promotional item loaded

into the vending machine coupled with the expressed requirement that there be at least one promotional item, there is no assurance to the user of the machine that upon depositing the required sum of money and punching the dispense button that a promotional item will be dispensed.

If the user wins a promotional item the teaching of the patent is to stuff money or a coupon into the promotional item so that upon unpacking the promotional item the user can then use the money to purchase the product. If the user has the promotional item in his hand and the return of money the user just put into the machine why bother to put the money back into the machine??? The user has won the gamble. The user has the tee shirt for free and can just walk away a winner. The patent teaches placing money into the tee shirt but indicates that it can be any sum of money not limited or required to be the sum of money initially placed into the vending machine to obtain the promotional item; another express teaching of gambling in the patent.

The Beckman/Perez product and the Beckman/Perez process patent applications use;  
A filled beverage bottle;  
A filled snack package; and  
An envelope to attach said filled snack package to said filled beverage bottle as a unit to be placed into an existing vending machine to be dispensed as a unit in a single transactional step.

The Kaufman apparatus/process does not teach dispensing the product AND the promotional item as a unit. The teaching is a two step process. Place money into the vending machine and punch dispense. If what is dispensed is a promotional item, open the promotional item container and find money or a coupon that may be use in a second transaction of placing the money or coupon into the vending machine to be able to activate the dispense mechanism of the machine.

The user at this point can just walk away with the promotional item and the money or coupon without any requirement to deposit the money or coupon into the vending machine. The coupon can be used at a later time and may win the "at least one promotional item" again just using the coupon to obtain the tee shirt and gambling on receiving another winner of money or another coupon.

As Kaufman does not teaching  
Using a binding device to make the promotional product and the product a unit to be dispensed upon the activation of the dispensing mechanism of the vending machine;  
Using a filled beverage container; or  
Using a filled snack container;

But Kaufman does teach gambling;

The examiner on page 2 of the office action, second to the last paragraph, states that Kaufman shows the vending machine storage rack compartments (30) (FIGURE 6 does not contain a number (30).with said combination of beverage and article (shirts; Figure 6) configured assembled as a unit (Col. 4 line 65-Col5 line 10)

Applicant's attorney respectfully strongly traverses examiner's opinion.

Figure 6 includes;

A promotional item generally designated 240;  
The promotional item 242 shown filling a container 252;  
A unassigned number 244;  
A half bottle, 252a;  
Another half bottle 252b;

A label 256 used to hold the two half bottles together; and  
Two rows of perforations 245.

There is NO beverage, no room for a snack in the container holding the t-shirt, the two half bottles are not water tight nor does the shrink wrap/label 256 combine anything but the two half bottles. No promotional item and product are combined within the shrink wrap/label AS A UNIT as stated by the examiner.

The Examiner references Col 4 line 65- Col 5 line 10. The specification expressly describes loading with TWO separate items, the promotional 40 and the product 50 with the ratio of item 40 to item 50 being between 100 to 1 and 5 to 1 to provide adequate INCENTIVE (emphasis added to illuminate the GAMBLING odds that can be set by the house) for encouraging the purchase from the Kaufman gambling machine.

The examiner continues on page 5 that the replenishment function consists of selection of said filled beverage container (FILLED WITH A SHIRT) no beverage whatsoever is in the container; and said preconfigured article (shirt; Figure 10) as a unit with a retaining device (256; Figure 10) as a unit.

The specification, col 6 line 53 -65 expressly teaches using the label 256 to secure the two pieces of bottle, 252a and 252b together. No beverage, no snack, no product.

The examiner expressly admits on page 3, third paragraph that “Kaufman does not disclose the container unit as comprising a beverage and a snack product.” But the examiner continues to contend that it would be obvious to modify the teaching of Kaufman to replace the free T-shirt with a snack. BUT KAUFMAN IS MISSING THE BEVERAGE. THE BOTTLE IS CUT IN HALF. NO SECOND CONTAINER IS RETAINED WITH A SECOND BOTTLE to be dispensed as a unit. The dispensing is taught to be one promotional item with money/coupon to deposit for a second dispensing of the product.

On page 4, the examiner contends that Kaufman teaches assembly at the site of the vending machine. Kaufman in col 6, lines 24 -45 teaches using an empty product container which usually contains soda but the soda must be dumped out at the site, and the promotional product must be compressed, at the site, so that it may be stuffed into the empty soda bottle (after the band saw is used to cut the soda bottle in half) and then shrink wrap is applied over the two half bottles and compressed free t-shirt. The band saw and shrink wrap cutter and heater can then be packed up and carted to the next maintenance stop. The t-shirt fills the empty soda bottle, no room for a snack. The retaining device holds the two half bottles together, no snack package is included within the retaining device.

On page 4, the examiner has cited Beckman (more properly Beckman/Perez) (US 2005/0118309A) (hereafter Beckman) a published patent application as prior art under 35 U.S.C. 103(a). The attached affidavit shows the common ownership of the cited prior art and the present application. Thus, Applicant’s Attorney respectfully requests the withdrawal of Beckman as prior art.

The examiner continues on page 5 to characterize Kaufman as being a combination of a beverage bottle and a snack to which the limiting disk of Beckman could be applied to the beverage cap of Kaufman to retain a snack. As shown above, Kaufman does not use a FILLED beverage container; therefore there is no beverage in Kaufman. Kaufman does not leave any room in any container for snack; (Claim 1, col 8 lines 25-34 – the compressed fabric article having an outer diameter at least equal to the inner diameter of the plastic bottle...: Claim 6, col 8 lines 60 65, “the two pieces of the bottle completely enclose the compressed fabric article”; Claim 10, col 9, lines 31-43, “a plastic bottle ...cut in tow(sic) parts urging against the



inner peripheral surface “ so that the container is filled with a t-shirt; and claim 12, Col 10, lines 21-31 all expressly leave no room in the bottle for a snack with the compressed t-shirt article. If Beckman teaching is applied to Kaufman as suggested by the examiner the result would be the dispensing on a single item – the product or the promotional item alone, no combination is possible unless the examiner is suggesting stuffing the t-shirt into a filled beverage bottle. Applicant’s attorney suggests this is not a marketable solution.

Further, Kaufman claims require placing product items, each having the same size and shape as the container containing the product into the storage compartment. No combination of product container and promotional container is claimed or taught by the specification.

On page 5 of the office action the examiner continues in his opinion that Kaufman includes a beverage container filled with a beverage to be assembled with a snack by means of a limiting disk of Beckman enhances by the plurality of rings taught by Singer. Kaufman does not assemble a beverage bottle filled with a beverage and only secures the two half beverage bottles together with some device. The limiting disk of Beckman applied to the cap of Kaufman would merely hold the top of the Kaufman container leaving the two half containers to spill the contents of the compressed fabric article within the storage compartment of the Kaufman gambling machine.

For all the reasons set forth above, Applicant’s attorney respectfully requests examiner to withdraw Kaufman as proper prior art to the Beckman/Perez applications.

This response is filed concurrently with a request for further examination. The complete review of all of the arguments of the prior response to office action declared moot by the examiner as well as the renewed and sometimes repetitive arguments contained in this response is respectfully requested.

Applicant’s attorney respectfully sets forth his opinion that the examiner will find the teaching in this Patent Application of Beckman/Perez inventive over the prior art and will reinstate at least the matter found allowable if not the complete application.

The response consists of:  
Request for Continued Examination, file name sb0030e\_fill.pdf  
Amendment After Final, file name response3-17-09.pdf; and,  
Amendment After Final, filename claims.pdf.

Respectfully submitted,  
/s JOHN E. HALAMKA, 30177/  
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